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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,050	11/25/2003	David H. Deaton	DEA9902DV	7773

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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/723,050		DEATON, DAVID H.	
	Examiner		Art Unit	
	Paul B. Prebilio		3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claim 3 is objected to because of the following informalities:

The preamble of claim is not consistent with the base claims that are drawn to a graft "kit." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 8, 9, and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Shmulewitz (US 5,961,548). Shmulewitz anticipates the claim language where the tubular graft as claimed is the main portion (12) of Shmulewitz (see Figure 1), the fenestrations as claimed are the perforations (see Figure 3A and column 4, lines 14-35), the catheter as claimed is catheter (40) (see Figures 6A to 6C and column 5, lines 1-67), the guidewire as claimed is guidewire (65), and the piecing element on the guidewire as claimed is the nose cone (49); see column 5, lines 24-29.

With regard to claim 8, the Examiner asserts that "rearward facing" does not distinguish the guidewire claimed from that of Shmulewitz because rearward is a direction that has no orientation with respect to anything else. Likewise, proximal and

Art Unit: 3738

distal ends of Shmulewitz can be either end of the guidewire (65) and does not necessitate that the distal end be the one shown piercing the graft of Shmulewitz.

Regarding claim 25, the relative stiffness is not compared to any known value or to the rest of the guidewire, and for this reason, it can be of any stiffness.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shmulewitz (US 5,961,548) in view of Wisselink (US 5,984,955). Shmulewitz meets the claim language as explained *supra* but fails to disclose the use of a grommet or flange for the sidebranch graft attachment as claimed. However, Wisselink teaches that it was known to use grommets and flanges with similar such grafts as a means to securely attach the side graft with the main graft; see the figures and column 3, line 35+. Therefore, it is the Examiner's position that it would have been obvious to use a grommet or flange with the Shmulewitz side graft for the same reasons that Wisselink uses the same or to securely attach the two grafts together.

Claims 10-16, 18, 21, 22, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dereume et al (US 5,723,004) in view of Shmulewitz (US 5,961,548). Dereume meets the claim language except for clearly disclosing a guidewire that is capable of forming an opening in the graft wall as claimed; see Figures

3, 4, and 9-13 as well as columns 4 to 6. However, Shmulewitz teaches that it was known to make guidewires capable of forming openings in similar grafts; see the previously cited portions *supra*. Therefore, it is the Examiner's position that it would have been obvious to include a guidewire in the Dereume invention that is capable of forming openings in the graft wall for the same reasons that Shmulewitz includes the same or to make the openings optional to the user.

With regard to claim 14, the grafts of Dereume are considered separable to the extent that this language can be given patentable weight because one could at least cut them apart.

With regard to claims 15 and 16, Dereume fails to disclose fenestrations in the form of slits in two different orientations. However, Shmulewitz teaches that it was known to make fenestrations as perforations so that they can be expanded to the extent desired. Therefore, it is the Examiner's position that it would have been obvious to make the openings (37) of Dereume in the form of expandable slits for the same reasons that Shmulewitz does the same.

With regard to claim 18, Dereume fails to disclose a side branch graft therewith. However, Shmulewitz teaches that it was known to use such in similar devices. Therefore, it would have been obvious to use a side branch graft in order to better direct the blood flow and to prevent blood and blood pressure from being exposed to the diseased vessel wall.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dereume and Shmulewitz as applied to claims 10-16, 18, 21, 22, and 27-30

Art Unit: 3738

above, and further in view of Wisselink (US 5,984,955). Dereume as modified by Shmulewitz fails to teach the concept of using grommets or flanges to attach side grafts to main grafts as claimed. However, Wisselink teaches that it was known to use grommets and flanges with similar such grafts as means to securely attach the side graft with the main graft; see the figures and column 3, line 35+. Therefore, it is the Examiner's position that it would have been obvious to use a grommet or flange with the Shmulewitz modified Dereume side graft for the same reasons that Wisselink uses the same or to more securely attach the two grafts together.

Response to Arguments

Applicant's arguments filed January 6, 2006 have been fully considered but they are not persuasive. In the paragraphs number 10 and 11 on page 9 of the response, the Applicant argues that there is no piercing element on the guidewire in Shmulewitz. The Examiner respectfully disagrees. The piercing element is the nose cone (49) and it is clearly on the guidewire (65); see Figures 6C. For this reason, the rejections have been maintained.

With regard to the traversal of the claim 8 rejection, the Examiner has explained why the claim language is still considered met thereby. The Applicant is directed to the claim 8 explanation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3738

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Prebilic", with a stylized flourish at the end.

Paul Prebilic
Primary Examiner
Art Unit 3738